

012.P57001

**REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action, dated January 26, 2006. Claims 1 and 3-8 are pending. No claims are currently amended. Claims 1 stands rejected under 35 USC § 112, second paragraph. Claims 1 and 3-8 stand rejected under 35 USC § 102(e) over US Patent Publication No. 2005/0058149 of Howe (hereinafter, Howe). In addition, Claim 6 has been objected to by the Examiner. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

With regard to the Examiner's rejection under 35 USC § 112, second paragraph, Assignee respectfully asserts that the Examiner has failed to establish a prima facie case that Assignee's claim 1 is unpatentable. In addition, MPEP § 706.03(d) states that "[w]henver possible, [the Examiner should] identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite." The Examiner asserts that claim 1 is generally narrative and indefinite. Assignee respectfully requests that the Examiner point out particular portions of claim 1 that do not satisfy 35 USC § 112, second paragraph. Absent any such specificity from the Examiner, Assignee respectfully asserts that the Examiner has not established a prima facie case that claim 1 does not satisfy 35 USC § 112. In addition, Assignee respectfully asserts that claim 1 apprises one of ordinary skill in the art of its scope and, therefore, complies with 35 USC 112, second paragraph. See Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, at 1378-1379 (Fed. Cir. 2000). Assignee would also like to note that MPEP § 2173.02 states that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Furthermore, MPEP § 2173.04 states that "[b]readth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)." While one of ordinary skill in the art may interpret Assignee's claim 1 to be broad, it is clear under the law that "breadth is not to be equated with indefiniteness." In re Miller, 441

012.P57001

F.2d 689, 169 USPQ 597, at 600 (CCPA 1971). Therefore, Assignee respectfully requests that the Examiner withdraw this ground for rejection.

With regard to the rejection under 35 USC § 102(e), Assignee respectfully asserts that the Examiner has failed to establish a prima facie case of unpatentability because Howe does not satisfy the requirements of 35 USC § 102(e). Specifically, 35 USC § 102 states that:

A person shall be entitled to a patent unless ...

e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

Assignee respectfully would like to note that the present application was filed February 9, 2001 and claims priority to a provisional application filed February 15, 2000. Assignee would also like to note that Howe has a filing date of September 26, 2004. While Assignee does not concede that Howe would anticipate the rejected claims if filed sufficiently earlier in time to satisfy 35 USC § 102(e), it is clear that Howe does not satisfy either requirement of 35 USC § 102(e). Specifically, Howe does not satisfy 35 USC § 102(e)(1) because Howe was not filed before the present application. Likewise, Howe does not satisfy 35 USC § 102(e)(2) because Howe is not a patent granted on an application filed before the present application. It is therefore respectfully requested that the Examiner withdraw this ground for rejection.

With regard to the Examiner's objection to the language "capable of" in claim 6, Assignee respectfully asserts that the Examiner has not established a proper basis for this objection. Specifically, the Examiner has not established that the language "capable of" is an informality of language. In addition, Assignee respectfully asserts that within the framework of MPEP §2106, cited by the Examiner, the Examiner has not established that "capable of" does not limit claim 6. In the context of claim 6, "capable of", along with the language that follows, constitutes at least one claim

012.P57001

limitation. The Examiner has not established any basis for his assertion to the contrary. In addition, Assignee would again like to note that MPEP § 2173.04 states that "[b]readth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)." While one of ordinary skill in the art may interpret "capable of" to be broad, it is clear under the law that "breadth is not to be equated with indefiniteness." In re Miller, 441 F.2d 689, 169 USPQ 597, at 600 (CCPA 1971). Therefore, Assignee respectfully requests that the Examiner withdraw this objection to claim 6.

For at least the reasons above, Assignee respectfully submits that claims 1 and 3-8 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments may exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections and objections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

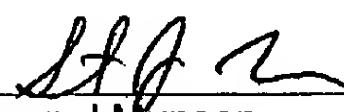
012.P57001

**CONCLUSION**

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: 5-26-06  
\_\_\_\_\_  
Steven J. Munson  
Reg. No. 47,812

Customer No. 43831  
Berkeley Law and Technology Group, LLC  
1700 NW 167<sup>th</sup> Place, Suite 240  
Beaverton, OR 97006  
503-439-6500

**CERTIFICATE OF FACSIMILE TRANSMISSION**


*I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on:*

May 26, 2006

Date of Transmission

Ilka Dalton

Name of Person Transmitting Correspondence

  
\_\_\_\_\_  
Signature